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By:

Nancy Foster



PATENT

Customer No. 22,852  
Attorney Docket No. 06843.0052-00000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: )  
Sanjay D. KHARE ) Group Art Unit: 1646  
Application No.: 10/748,112 ) Examiner: MERTZ, Prema Maria  
Filed: December 29, 2003 )  
For: COMBINATION THERAPY WITH ) Confirmation No. 1751  
CO-STIMULATORY FACTORS )

**MAIL STOP AMENDMENT**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**RESPONSE TO OFFICE ACTION (RESTRICTION REQUIREMENT)**

Applicant now responds to the Office Action (Restriction Requirement) mailed March 1, 2007 ("the Second Restriction Requirement"). The period for reply has been extended two months by the Petition for Two Month Extension of Time and required fee filed herewith. The Examiner required restriction to one of three different groups. See Second Restriction Requirement at pages 2 to 3.

Applicant elects Group 58, claims 104, 110, 113 to 116, and 119 to 121, with traverse.

In the Second Restriction Requirement, the Examiner subdivided the same claims into three different groups without acknowledging that any of those claims are linking claims. The Examiner did the same thing in the previous Office Action, mailed

September 26, 2006 ("the First Restriction Requirement"). As applicants noted in the Response to the First Restriction Requirement, "[w]here inventions as disclosed and claimed are both (A) species under a claimed genus and (B) related, then the question of restriction must be determined by both the practice applicable to election of species and the practice applicable to other types of restrictions.... If restriction is improper under either practice, it should not be required." MPEP § 806.04(b) at 800-42. Furthermore, "[t]here are a number of situations which arise in which an application has claims to two or more properly divisible inventions, so that a requirement to restrict the claims of the application would be proper, but presented in the same case are one or more claims (generally called 'linking' claims) inseparable therefrom and thus linking together the otherwise divisible inventions" MPEP § 809 at 800-52. "**Linking claims must be examined with and thus are considered part of the invention elected.**" *Id.* (emphasis added.)

In this case, the Examiner has defined three groups. See Second Restriction Requirement at pages 2 to 3. Each of those groups consists of the exact same claims, claims 104, 110, 113 to 116, and 119 to 121. See *id.* Thus, at least independent claim 104 should be identified as a linking claim.

For the reasons already discussed in the Response to the First Restriction Requirement, the Examiner cannot force the applicant to amend the claims by requiring restriction to particular species and refusing to examine a generic claim. Because the Examiner has no authority to force applicants to limit the scope of the claim through a restriction requirement, if the Examiner maintains the present restriction requirement, and the elected group is found allowable, applicant understands that **the Examiner**

**must continue to search and examine the full scope of the elected claims to determine their patentability as written according to MPEP § 809.**

Additionally, claims 117 and 118 were originally included in Group 58 in the First Restriction Requirement, and, as the Examiner noted in the Second Restriction Requirement, "Applicants have elected Group 58 (claims 104, 110, 113-121)...." See the Second Restriction Requirement at page 2. The Examiner, however, has now further divided Group 58 into Group 58, Group 117, and Group 118. None of those groups contain claims 117 and 118. The Examiner has not provided any explanation for the omission of those claims from the Groups, nor has the Examiner placed claims 117 and 118 in a new group. Applicant assumes, therefore, that the omission of claims 117 and 118 was an error and asserts that the elected Group 58 still includes claims 104, 110, and 113 to 121. In the event the Examiner intended to remove claims 117 and 118 from Group 58, Applicant requests that the Examiner issue a new Restriction Requirement indicating the reason for the removal of those claims.

In the event the Examiner feels that an interview would further prosecution, applicant requests that the Examiner contact the undersigned at (650) 849-6658.

Please grant any extensions of time required to enter this Response, and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: June 1, 2007

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